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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,362	01/05/2004	Radhakrishnan Janardanan Nair	AA611	2195
27752 7590 05/30/2008 THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION - WEST BLDG. WINTON HILL BUSINESS CENTER - BOX 412 6250 CENTER HILL AVENUE CINCINNATI, OH 45224				
EXAMINER				
CHAPMAN, GINGER T				
ART UNIT		PAPER NUMBER		
3761				
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05/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/751,362

Applicant(s)

NAIR ET AL.

Examiner

Ginger T. Chapman

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 22-29 is/are pending in the application.
4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 1-9, 11 and 22-23 and 24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 26-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 20, 2008.

Status of the claims

Claims 22-29 were added by way of Amendment file date February 6, 2008; claims 10 and 12-21 are cancelled; claims 1-9, 11 and 22-29 are pending in the application; claims 3 and 5-9 are rejoined and examined under 37 CFR 1.104, claims 25-29 are withdrawn from consideration as being drawn to nonelected species comprising printed sheet material component material layer, as being generic to the named species and as not depending from or otherwise requiring all the limitations of an elected generic claim; claims 1-9, 11 and 22-24 are examined on the merits.

Response to Arguments

2. Applicant's arguments see Remarks, p. 6 out of 7, filed February 20, 2008, with respect to previously restricted claims 3 and 5-9: List 1: Species 1: predetermined selected order of articles; and Species 2: randomly selected order of articles, as being encompassed by the election of species with respect to the sheet material comprising the component material: List 2: Species A-E selected wherein the sheet material component material is Species A: a backsheet, have

been fully considered and are persuasive. The restriction between Species A and B has been withdrawn.

3. Applicant's arguments filed 12 November 2007, with respect to the rejection of claims 1, 2, 4 and 12, under 35 USC 102(c), have been fully considered but they are not persuasive.

4. Applicant argues the following:

5. (a) The prior art, Pargass, teaches the graphics 21 are printed on an appliqué sheet 26 which is then applied to the nonwoven material comprising the garment facing layer of the outer cover 22, while the instant claims recite the graphic are printed directly on the nonwoven material comprising the garment facing layer of the outer cover.

6. This argument is not persuasive for the following reasons:

7. (a) Both the instant and the prior art graphics are printed on nonwoven material comprising the outer cover of the article. Outer covers are known in the art to comprise laminates of garment-facing nonwovens in multiple layers, and therefore printing on a nonwoven layer does not define any new and unobvious functional relationship between the printed matter and the substrate. Therefore the prior art anticipates the claimed limitation in accordance with § MPEP 2112.01, III, as reproduced *infra*. Therefore the rejection stands as stated.

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to

the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9, 11 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Pargass et al (US 6,558,499).

Claim 1: Pargass et al disclose an absorbent product (10) comprising a package and at least n absorbent articles contained in the package, wherein n is greater than 10 (column 5, lines 3-5), each of the absorbent articles having a body contacting surface (14) and a garment contacting surface (22) opposing the body contacting surface, each of the absorbent articles comprising: a component material (26) disposed between the body contacting surface (14) and a garment contacting surface (22), the component material (26) having a printed graphic (21, 21') printed directly on the garment contacting surface comprising the outer layer of the backsheet (figs. 1 and 2); wherein the printed graphic (21, 21') of each of the n absorbent articles is different from the graphic of each of the remaining absorbent articles (c. 15, ll. 44-52 and c. 15, ll. 60 to c. 16, ll. 1-2) and all of the printed graphics (21, 21') of the n absorbent articles have a predetermined association (c. 10, ll. 17-21; see also c. 6, ll. 59; c. 7, ll. 12-15; c. 10, ll.36-37). See also c. 2, ll. 9-13, disclosing that printed graphics having a predetermined association are known in the diaper art.

With respect to claim 2, Pargass et al disclose the predetermined association includes a predetermined order (c. 10, ll. 17-21; see also c. 10, ll. 36-37; c. 7, ll. 12-15; c. 6, l. 59, and the n absorbent articles are stacked in the package in accordance with the predetermined order (c. 15, l. 60-67 to c. 16, ll. 1-2).

8. With respect to claims 3 and 5-9, reciting content and randomness of the graphics, the critical question is whether there is any new and unobvious functional relationship between the printed graphics and the substrate, as per MPEP § 2112.01, III. Here, the answer is no, because Both the instant and the prior art graphics are printed on nonwoven material comprising the outer cover of the article. Outer covers are known in the art to comprise laminates of garment-facing nonwovens in multiple layers, and therefore printing on a nonwoven layer does not define any new and unobvious functional relationship between the printed matter and the substrate. Therefore the prior art anticipates the claimed limitation in accordance with § MPEP 2112.01, III, as reproduced *infra*. Therefore the rejection stands as stated.

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate."). MPEP § 2112.01, III.

With respect to claim 4, Pargass et al disclose the predetermined order is an order of usage instruction (c. 6, l. 59; see also c. 6, ll. 55-58).

With respect to claim 11, Pargass et al disclose n is selected from 11 to 120 (c. 5, ll. 4-5).

With respect to claim 22, reciting the limitation of inkjet printed graphics, Pargass discloses diapers having graphics printed thereon. The method of printing the graphic is a product-by-process limitation. Accordingly, § 2113 of the MPEP, some of which is reproduced below, dictates the manner in which the claims have been examined.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

It is further noted that the end product as claimed is a diaper not a method of printing graphics, i.e. if a garment of the prior art is the same as the end product in the claims, the claims are unpatentable even though it was made using one several methods of printing. Therefore, even if Pargass et al would teach inkjet printed diapers, since the end product of the prior art discussed *supra* is the same as the end product claimed, the claims are unpatentable.

With respect to claim 23, Pargass discloses the printed graphic (21, 21') is seen through either the body contacting surface or the garment contacting surface (figs. 1 and 2);

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pargass et al in view of Stavrulov (WO 00/13632).

With respect to claim 4, Pargass et al disclose, at c. 6, ll. 55-59, that the orders include, *inter alia*, an order of usage instructions, a sequential indication means and combinations thereof, but does not expressly disclose an order illustrating story, an order for daily activity, an order for educational training, an order illustrating child care tips, and an order of sales promotion. Stavrulov, at page 3, lines 15-22 expresses the desire and clear motivation to increase the attractiveness of diapers with graphics in the form of texts and pictures of educational, entertaining, instructive or other nature attractive to a consumer thereby increasing consumer demand for the product. Stavrulov teaches diapers in packages having printed graphics in predetermined associations including, *inter alia*, an order illustrating story, (p. 7, l. 24) an order for daily activity (p. 7, l. 20-23), an order for educational training (p. 7, l. 18), a sequential indication means (p. 7, ll. 19-21), an order of usage instruction (p. 1, l. 20-21), an order illustrating child care tips (p. 7, l. 21), and an order of sales promotion (p. 12, l. 2).

Further, Stavrulov teaches the images do not repeat (p. 8, ll. 9-22). Stavrulov teaches the benefit of each of the printed graphics being different from each other graphic in the package of diapers is that the consumer receives the maximum educational, entertaining and instructional information with each purchase (p. 8, ll. 23-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the variety of graphics having predetermined orders as taught by Stavrulov in the predetermined order of graphics printed on the component material of the diapers of Pargass et al since Stavrulov states

at page 11, lines 11-16 that such graphics attract consumer attention and stimulate the purchase of the product by the consumer.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pargass et al in view of Ungpiyakul et al (US 55,286,543) incorporating Pazdernik (US 4,753,649 A).

9. With respect to claim 23, Pargass discloses the claimed invention except for the graphic printed on a garment facing surface of microporous film material. Claim 22 is directed to a graphic printed on a substrate material which comprises a backsheet, said backsheet comprising a laminate including an outer, garment facing nonwoven layer and an inner, body facing film layer. Pargass, incorporating by reference Ungpiyakul '543, made of record by examiner in a previous Office action, mail date October 31, 2005), teaches that the material on which the graphic is printed can comprise the material of Pazdernik '649 (c. 8, ll. 1-19), thus providing motivation for using the material. Pazdernik '649 teaches the material comprises backsheet 12 and consists of film material composed of polyethylene (c. 5, ll. 64-68 to c. 6, ll. 1-3), disclosed in the instant specification, at p. 10, l. 29, as a suitable embodiment of the instant disclosed invention. Therefore Ungpiyakul teaches the material of Pasternak is suitable for receiving printed graphics and for forming the garment facing surface of an outer cover of an absorbent article.

10. Ungpiyakul teaches the Pazdernik material for printing graphics directly thereupon (c. 8, ll. 1-20) for tape tabs which are integral with the backsheet in forming the garment facing surface of the article, thus anticipating claim 22. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the graphics of Pargass on the

material of Ungpiyakul since Ungpiyakul teaches this material is suitable as material for absorbent articles.

Allowable Subject Matter

11. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record teaches printing the graphic on the substrate material comprising a nonwoven garment facing surface of an outer cover (Pargass), and a film layer (Pazdernik, US 4753649 A). The subject matter not found is printing the graphic printed directly on a garment facing surface of a microporous film material in combination with the garment facing microporous film material comprising an outer cover backsheet material including a inner film material layer and an outer nonwoven material layer joined with the microporous film material wherein the printed graphic printed directly on the film layer is visible through the nonwoven material layer.

Conclusion

13. Applicant's amendment, filed February 6, 2008, re-filed February 20, 2008 after restriction, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3761

/Ginger T Chapman/
Examiner, Art Unit 3761
5/23/08

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761